

REMARKS

As a threshold matter, Applicants note that the Examiner has not indicated that the references included in Applicants' supplemental Information Disclosure Statement (IDS) filed June 13, 2005 have been considered, although this IDS was mailed only shortly before the Examiner's Non-Final Office Action was sent on June 15, 2005. Applicants respectfully request that the Examiner acknowledge consideration of the references of this IDS by initialing each reference on a copy of the IDS and returning the copy to the Applicants' representative.

Overview

Claims 51-53, 55, 57-62, 66-74, 76-129, and 132-143 currently stand allowed.

The Examiner also responded in the prior Office Action as follows: rejected claims 75, 130 and 131 under 35 U.S.C. § 101 as being directed to non-statutory subject matter due to a lack of recitation of computer hardware; and rejected claims 130 and 131 under 35 U.S.C. § 102(b) as being anticipated by Theimer et al. (U.S. Patent No. 5,611,050).

Applicants hereby amend claims 130 and 131 to clarify the subject matter of their invention, and add new claims 144-191. Thus, claims 51-53, 55, 57-62 and 66-191 are now pending.

Discussion

Applicants thank Examiner Hailu for the indication of allowable subject matter in the pending claims. In addition, Applicants thank Examiner Hailu for his consideration during the telephone interview with Applicants' representative on May 12 and 13, 2005 regarding this application, during which Applicants' representative and the Examiner discussed whether claims 75, 130 and 131 were in condition for allowance.

With respect to the rejection of independent claims 130 and 131 under 35 U.S.C. § 102(b) as being anticipated by Theimer, each of the claims has been amended to contain language

similar to that of method claim 90, and thus are believed to be allowable over Theimer and the other cited art for at least the same reasons as claim 90.

With respect to the rejection of claims 75, 130 and 131 under 35 U.S.C. § 101 as being directed to non-statutory subject matter due to a lack of recitation of computer hardware, however, Applicants believe that this rejection is not supported by caselaw or current policy of the United States Patent and Trademark Office (“USPTO”), and note that the Examiner’s rejection was issued prior to the recent decision by an expanded panel of the Board of Patent Appeals and Interferences in the matter of *Ex parte Lundgren*, Appeal No. 2003-2088 (Precedential BPAI opinion September 2005). In *Lundgren*, the Board rejected an Examiner’s argument that the claimed invention was “outside the technological arts” because it lacked “disclosure or suggestion of computer, automated means, [or] apparatus of any kind” (*Lundgren*, page 4, emphasis added), and further reiterated that no separate “technological arts test” even exists.

Subsequent to the *Lundgren* decision, the USPTO issued new “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (hereinafter “Interim Guidelines”) in October 2005 (see www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf), in which the USPTO discussed various caselaw relevant to statutory subject matter with regard to 35 U.S.C. § 101. The analysis presented in these Interim Guidelines includes the following:

a complete definition of the scope of 35 U.S.C. § 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent. The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. *Interim Guidelines*, page 13, emphasis added.

and

The scope of 35 U.S.C. § 101 is the same regardless of the form or category of invention in which a particular claim is drafted. *AT&T*, 172 F.3d at 1357, 50

USPQ2d at 1451 . See also State Street, 149 F.3d at 1375, 47 USPQ2d at 1602 wherein the Federal Circuit explained

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter - - [provided the subject matter falls into at least one category of statutory subject matter] but rather on the essential characteristics of the subject matter, in particular, its practical utility.

For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter it belongs in, does not affect the analysis to be performed by the examiner. Note that an apparatus claim with process steps is not classified as a "hybrid" claim; instead, it is simply an apparatus claim including functional limitations. *Interim Guidelines*, page 15, emphasis added.

In accordance with the current caselaw and the Interim Guidelines, Applicants believe that it is clear that pending claims 195 and 198 are within the four statutory categories of invention (*e.g.*, as statutory machines), and that the subject matter of the claims does not fall within one of the three exclusions of abstract ideas, laws of nature and natural phenomena. The claims each recite a practical utility or application, and as such are statutory subject matter. As the Federal Circuit has made clear on numerous occasions, a general-purpose computing system that is configured to perform a specific function is statutorily a new machine (see, for example, *In re Lowry*, 32 F.3d 159, Fed. Cir. 1994, where the court affirmed that "if a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program"). Furthermore, the Federal Circuit ruled *en banc* in *In re Alappat*, 33 F.3d 1526, Fed. Cir. 1994 that the following machine claim was statutory subject matter as a statutory new machine, despite the objections of the USPTO in that case that no hardware was explicitly recited in the body of the claim – please note the similarity in structure of the body of the claim below to that of pending claim 131 rejected on that same basis.

A rasterizer for converting vector list data representing sample magnitudes of an input waveform into anti-aliased pixel illumination intensity data to be displayed on a display means comprising:

- (a) means for determining the vertical distance between the endpoints of each of the vectors in the data list;
- (b) means for determining the elevation of a row of pixels that is spanned by the vector;
- (c) means for normalizing the vertical distance and elevation; and
- (d) means for outputting illumination intensity data as a predetermined function of the normalized vertical distance and elevation.

Thus, in accordance with the caselaw of the Federal Circuit and the USPTO's Interim Guidelines, claims 75, 130 and 131 are statutory new machines that are patentable subject matter.

In addition to the clear directions of the Federal Circuit with respect to the statutory nature of such machine claims, the caselaw and Interim Guidelines further make clear that the statutory subject matter analysis is the same "regardless of the form or category of invention in which a particular claim is drafted", and the Lundgren decision (in accordance with prior Federal Circuit caselaw) reiterated that "disclosure or suggestion of computer, automated means, [or] apparatus of any kind" is not needed to place a method claim in statutory form. Thus, for the same reasons that Lundgren found method claims to be patentable without a recitation of any computer hardware, machine claims 75, 130 and 131 are further patentable for those reasons.

Thus, Applicants believe that any perceived lack of recitation of hardware claim elements in claims 75, 130 and 131 is an inappropriate basis for rejection of the claims with respect to statutory subject matter, and that these claims are thus in patentable form.

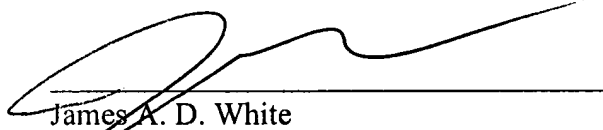
Applicants have also added new claims 144-191, each of which are believed to be patentable over the cited art for at least the same reasons as other previously allowed claims. In particular, new claims 144-191 each depend from one of independent claims 75, 127, 130, 131, 139 and 141, and are believed to be patentable for at least the same reasons as those claims.

Conclusion

In light of the above remarks, Applicants respectfully submit that all of the pending claims are allowable. Applicants therefore respectfully request the Examiner to timely allow all pending claims. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 694-4815.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,
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